

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	: Katsunari Tezuka et al.	Art Unit	: 1644
Patent No.	: 7,465,445	Examiner	: Ilia I. Ouspenski
Issue Date	: December 16, 2008	Conf. No.	: 9815
Serial No.	: 10/729,880		
Filed	: December 5, 2003		
Title	: METHODS OF PREVENTING OR TREATING GRAFT VERSUS HOST REACTION BY ADMINISTERING AN ANTIBODY OR PORTION THEREOF THAT BINDS TO AILIM		

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)

Patentee hereby requests reconsideration of the Patent Term Adjustment (PTA) accorded the above-referenced patent. Reconsideration of the final PTA calculation to increase total PTA from 672 to 1,272 days, is respectfully requested.

REMARKS

“A Delays” are defined as delays by the U.S. Patent and Trademark Office (PTO) under 35 U.S.C. § 154(b)(1)(A), which guarantees prompt PTO response. “B Delays” are defined as delays by the PTO under 35 U.S.C. § 154(b)(1)(B), which guarantees no more than three year application pendency. To the extent that the periods of delay overlap, the period of any term adjustment shall not exceed the actual number of days the issuance of the patent was delayed. 35 U.S.C. § 154(b)(2)(A). As outlined in Wyeth et al. v. Jon W. Dudas (U.S. District Court, D.C., CA No. 07-1492, Mem. Op. September 30, 2008), the only way that these periods of time can “overlap” is if they occur on the same day. If an “A delay” occurs on one calendar day and a “B delay” occurs on another calendar day, they do not overlap and 35 U.S.C. § 154(b)(2)(A) does not limit the extension to one day. Id.

The PTA for the instant patent, as currently calculated and shown on the face of the patent, apparently relies on the premise that the application was delayed under

CERTIFICATE OF MAILING BY EFS-WEB FILING

I hereby certify that this paper was filed with the Patent and Trademark Office using the EFS-WEB system on this date: January 8, 2009

35 U.S.C. § 154(b)(1)(B) *before* the initial three-year period expired. The Wyeth v. Dudas court determined that this construction cannot be squared with the language of

35 U.S.C. § 154(b)(1)(B), which applies “if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years.”

“B delay” begins only after the PTO has failed to issue a patent within three years, not before.

Id.

REVIEW OF PATENT TERM ADJUSTMENT CALCULATION

“A Delay”

A first PTO action was due on or before February 5, 2005 (the date that is fourteen months after December 5, 2003, the date on which the application was filed). The PTO mailed the first non-final Office Action on September 28, 2006, thereby according a PTO Delay of 600 days. Patentee does not dispute the PTO's calculation for this “A Delay” from February 6, 2005 (the day after the date that is fourteen months after the date on which the application was filed), to September 28, 2006. See 37 C.F.R. §§ 1.702(a)(1) and 1.703(a)(1).

In view of the period of “A Delay” detailed above, the total “A Delay” for this patent should be calculated as 600 days.

“B Delay”

The period beginning on December 6, 2006 (the day after the date that is three years after the date on which the application was filed), and ending December 16, 2008 (the date the patent was issued), is 742 days in length.

In view of the period of “B Delay” detailed above, the total “B Delay” for this patent should be calculated as 742 days. The PTO calculated 142 days of delay for issuance of a patent more than three years after filing. Patentee respectfully submits that the PTO's calculation of this “B Delay” is incorrect and that the correct PTO Delay for issuance beyond three years from filing is 742 days. See 37 C.F.R. §§ 1.702(b) and 1.703(b).

Overlap of "A Delay" and "B Delay"

As detailed above, "A Delay" accumulated during the following period:

February 6, 2005, to September 28, 2006.

As detailed above, "B Delay" accumulated during the following period:

December 6, 2006, to December 16, 2008.

The "A Delay" and the "B Delay" overlap (i.e., occur on the same calendar day) for a total of 0 days.

Applicant Delay

Patentee filed an Information Disclosure Statement on September 5, 2007, subsequent to a reply filed on June 27, 2007. Patentee was accorded a delay of 70 days for a supplemental response. Patentee does not dispute the PTO's calculation for this Applicant Delay from June 28, 2007, to September 5, 2007. See 37 C.F.R. § 1.704(c)(8).

Terminal Disclaimer

This patent is not subject to a terminal disclaimer.

Conclusion

In consideration of the events described above, Patentee believes the PTA calculation of 672 days is incorrect. As such, Patentee respectfully requests reconsideration of the PTA in the following manner:

- 1) Total PTO Delay should be calculated as 1,342 days (i.e., the sum of 600 days of "A Delay" and 742 days of "B Delay" minus the 0 days of overlap);
- 2) Total Applicant Delay should be calculated as 70 days; and
- 3) Total PTA should be calculated as 1,272 days.

Applicant : Katsunari Tezuka et al.
Patent No. : 7,465,445
Issued : December 16, 2008
Serial No. : 10/729,880
Filed : December 5, 2003
Page : 4 of 4

Attorney's Docket No.: 14539-0005002 / JF-0082US-C1

Please apply the fee of \$200 required under 37 C.F.R. § 1.18(e) and any other required charges or credits to Deposit Account No. 06-1050, referencing Attorney Docket Number 14539-0005002.

Respectfully submitted,

Date: January 8, 2009



Jack Brennan
Reg. No. 47,443

Fish & Richardson P.C.
Citigroup Center
52nd Floor
153 East 53rd Street
New York, New York 10022-4611
Telephone: (212) 765-5070
Facsimile: (877) 769-7945